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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No. 10/073,842	Applicant(s) RODRIGUEZ ET AL.	
<b>Office Action Summary</b>	Examiner Christopher Grant	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 40,41,43-53 and 68-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39,42,54-67 and 78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-39, 42, 54-67 and 78, drawn to user selection of advertisements, classified in class 725, subclass 34.
  - II. Claims 40, 41, 43, 44 and 68-71, drawn to presenting advertisements only if it has been viewed less than a predetermined number of times, classified in class 725, subclass 36.
  - III. Claims 45-53 and 72-77, drawn to presenting advertisements based on total value for the advertisements presented, classified in class 725, subclass 32.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as selecting advertisements via an Internet system, invention II has separate utility such as presenting advertisements only if it has been viewed less than a predetermined number of times on a billboard in a stadium, and invention III has separate utility such as presenting advertisements based on total value for the advertisements presented via a digital audio receiver.

See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Hubert Barnhardt on 6/19/2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-39, 42, 54-67 and 78. Affirmation of this election must be made by applicant in replying to this Office action. Claims 40, 41, 43-53 and 68-77 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6, 11, 16-21, 24, 25, 28-37, 42, 54, 55, 60 and 65-67 are rejected under 35

U.S.C. 102(e) as being anticipated by Ngo et al. (Ngo).

Considering claims 1 and 54, Ngo discloses a method and corresponding system for providing advertising comprising:

- a) receiving user input for selecting an advertising parameter (i.e. variant of specific advertisements the viewer has selected, col. 6, line 67 – col. 7, line 5 or step 94 figure 10) , wherein the advertising parameter is stored in a memory (col. 6, line 67 – col. 7, line 9); and
- b) providing a user with an advertisement corresponding to the advertising parameter (step 96, figure 10), wherein logic at the headend (36) or set top box (38) provides the advertisements.

Claims 2 and 5 are met by the presentation of advertisements during a break in television programming described at col. 3, lines 27-30.

Claims 3 and 24 are met by user input or selections stored in memory (user input received in advanced) as described at col. 6, line 55 – col. 7, line 9.

Claim 4 is met by plural advertisements described at col. 6, lines 39-43.

Claims 6 and 55 are met by the variant of specific advertisements the viewer has selected (advertisements the viewer has selected, col. 6, line 67 – col. 7, line 5 or step 94 figure 10) and

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col. 3, lines 25-42 and col. 5, lines 24-38 indicate advertisement types such as food, cars and SUV.

Claims 11 and 60 are met by advertisements stored or downloaded as described at col. 7, lines 19-25 and col. 6, lines 50-54.

Claims 16 and 65 are met by the advertisements displayed as described throughout the entire reference including but not limited to at col. 6, lines 39-44.

Claims 17 and 66 are met by the advertisement displayed at each DHCT (set top terminal) as described at col. 6, lines 39-44.

Claims 18 and 67 are met by the presentation of advertisements during a break (predetermined time span) in television programming described at col. 3, lines 27-30.

Claim 19 is met by user input or selections stored in memory (user input received in advanced) but immediately prior to the advertisements being provided as described at col. 6, line 50 – col. 7, line 9.

Claim 20 is met by buttons on the remote control as described at col. 4, lines 4-11.

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Claim 21 is met by the user selecting an advertisement as described at col. 6, lines 39-54 or the selecting of another type of advertisement via the profile as described at col. 6, line 55 – col. 7, line 17.

Claim 25 is met by the presentation of advertisements during a break (an enabled viewing period) in television programming described at col. 3, lines 27-30.

Claim 28 is met by programs the user has watched that determines the type of advertisements presented as disclosed at col. 7, lines 1-3.

Claim 29 is met by the type of the advertisement that is not responsive to the type of television programs being provided (i.e. advertisements provided based on user selection/profile) as disclosed throughout the entire reference including but not limited to col. 6, line 55 – col. 7, line 35.

Claims 30-33 are met by the graphical, textual, video and audio advertisements described at col. 4, lines 26-29, col. 4, lines 49-54, col. 5, lines 40-41 and col. 6, lines 1-30.

Claim 34 is met by set top box (38) (col. 4, lines 42-54).

Claim 35 is met by subscriber network described at col. 3, lines 43-65.

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Claim 36 is met by real-time presentation of advertisements described at 6, lines 50-52.

Claim 37 is met by advertisements stored or downloaded as described at col. 7, lines 19-25 and col. 6, lines 50-54.

Claim 42 is rejected for the same reasons given above in the rejections of claims 1-3 and 6.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-15 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo.

Considering claims 12-15 and 61-64, Ngo fails to disclose that the advertisement is deleted from the DHCT after it is presented a predetermined number of times or after a predetermined number of user inputs, or after a predetermined time period or after a predetermined number of times by a plurality of DHCTs as recited in the claims.

Recall that Ngo discloses that the advertisement is stored or downloaded from the cable or content provider (col. 7, lines 19-25 and col. 6, lines 50-54). The memory device in Ngo is limited to the number of data it can hold. The Examiner takes Official Notice that it is



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notoriously well known in the art to use factors such as time, date, user's request, number of times viewed or used by viewer(s) etc. to delete old data from memory so that new data can be stored.

Therefore, it would have been obvious to one ordinary skill in the art to modify Ngo's system (if necessary) to include the advertisement to be deleted from the DHCT on various factors such as after it is presented a predetermined number of times or after a predetermined number of user inputs, or after a predetermined time period or after a predetermined number of times by a plurality of DHCTs, for the typical advantage of providing procedures on how and when to remove old data from a memory device to subsequently receive new data.

9. Claims 7-10, 22, 23, 26, 27 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo in view of Jonason et al. (Jonason).

Considering claims 7, 8, 10, 56, 57 and 59, Ngo fails to specifically disclose the number of times that an advertisement is presented is dependent on a number of times the advertisement is determined to have been viewed as recited in the claims.

Jonason discloses a method and corresponding system for providing television advertisement comprising providing an exposure table (50, figure 2) that enables a receiver to display an advertisement a certain number of times (col. 11, lines 13-15). Therefore, a receiver determines (col. 10, lines 7-15) a number of times an advertisement has been viewed and presents (col. 10, lines 40-45) the advertisement if it has been viewed less than a predetermined number

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of times. Also see the entire reference including but not limited to the abstract, col. 3, lines 1-37 and col. 11, lines 13-21. Jonason's system ensures that viewers are fully exposed to the advertisements.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Ngo's system to include the number of times that an advertisement is presented to be dependent on a number of times the advertisement is determined to have been viewed, as taught by Jonason, for the advantage of providing a mechanism to ensure that viewers are exposed to the advertisements.

Claims 9 and 58 are met by the combined systems of Ngo and Jonason, wherein Jonason discloses a value (2.00 for Cars 1 and 3.00 for Cars 2, see col. 10, lines 39-53).

Considering claims 22 and 23, Ngo fails to specifically disclose the advertisement parameter is determined by a television service provider or an advertisement provider as recited in the claims.

Jonason discloses a method and corresponding system for providing television advertisement comprising a service provider (12) and an advertisement provider (24), wherein an advertisement parameter is determined by the television service provider (12) (col. 5, line 55 – col. 6, line 11 and col. 6, lines 27 –54) or the advertisement provider (24) (col. 6, lines 12-26 and col. 9, lines 19-32). One advertisement parameter is the type of advertisements (cars, pleasure, toothpaste as illustrated in figure 2). Also see col. 9, lines 33-42 and col. 3, lines 14-26.

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Jonason's system provides an efficient mechanism for controlling the content and order of what is being displayed at the subscriber's location.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Ngo's system to include the advertisement parameter to be determined by a television service provider or an advertisement provider, as taught by Jonason, for the advantage of providing an efficient mechanism for controlling the content and order of what is being displayed at the subscriber's location.

Considering claims 26 and 27, Ngo fails to specifically disclose an enabled viewing period has a daily or weekly recurring schedule as recited in the claims.

Jonason discloses a method and corresponding system for providing television advertisement comprising providing advertisement during an enabled viewing period, wherein the viewing period has a daily or weekly recurring schedule for the advantage of controlling when and how long a subscriber may view advertisements. See col. 3, lines 27-37.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Ngo's system to include an enabled viewing period has a daily or weekly recurring schedule, as taught by Jonason, for the advantage of controlling when and how long a subscriber may view advertisements.

10. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo in view of Addington et al. (Addington).

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Considering claims 38 and 39, Ngo discloses broadcasting advertisements. However, he fails to specifically disclose the advertisement is transmitted to the DHCT via broadcast file system (BFS) and that the advertisement is categorized in a BFS subdirectory as recited in the claims.

Addington discloses a system comprising a broadcasting file system and categorizing data in a BFS subdirectory for the advantage of providing a more efficient and hierarchical file broadcasting system. See the abstract and col. 1, line 56 – col. 2, line 42.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Ngo's system to include the advertisement to be transmitted to the DHCT via broadcast file system (BFS) and that the advertisements to be categorized in a BFS subdirectory, as taught by Addington, for the advantage of providing a more efficient and hierarchical file broadcasting system.

11. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo in view of Jonason and further in view of Addington.

The limitations of claim 78 is the same as the combined limitations of claims 1-3, 6, 7, 9, 11, 18, 24, 25, 32, 33, 35 and 38. Therefore, claim 78 is rejected for the same reasons given above in the rejections of claims 1-3, 6, 7, 9, 11, 18, 24, 25, 32, 33, 35 and 38.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Hendricks et al. and Kitsukawa et al. disclose advertisement systems.

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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\_\_\_\_\_

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755.

The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Christopher Grant  
Primary Examiner  
Art Unit 2611

CG  
June 20, 2003